

**Remarks to the Office Action Dated August 26, 2004:**

**A. Status of the Claims**

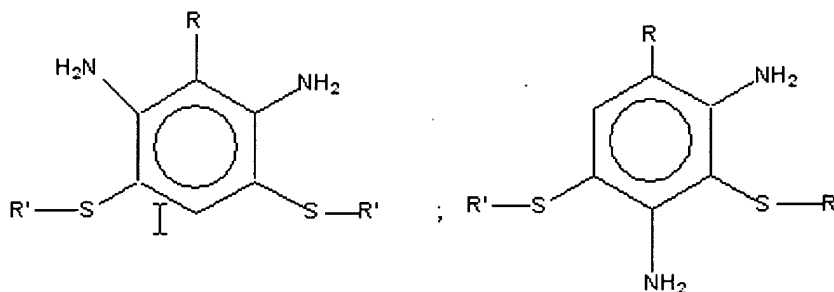
Claims 22-44 were pending at the time the Office Action dated August 26, 2004, was issued from the U.S. Patent Office. Claims 28, 31, 35, 39, and 43 have been amended and claim 44 has been canceled. Support for these amendments can be found throughout the specification and claims as originally filed. No new matter has been added. Claims 22-44 are currently pending.

**B. Claims 43 and 44 Comply With the Written Description Requirement**

The Action rejects claims 43 and 44 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Specifically, the Action contends that “within the specification, the 80/20 ratio refers to a blend of specific compounds, not to the claimed genus blend.” The Action, page 2.

Applicants disagree. Claims 43 and 44 satisfy the written description requirement under 35 U.S.C. § 112, first paragraph.

The specification, for example, provides written description for a claim directed towards “wherein the diamine is a mixture 80/20 by weight” of:



See, for example, the specification at page 18, lines 13-18, and originally filed claim 9. The written description rejection is therefore improper.

In an effort to further the prosecution of this case and to obtain commercially relevant claims at this time, however, Applicants note that claim 43 has been amended to be directed towards an 80/20 mixture of species of the above generic compounds. As noted in the above paragraph, however, this is not an acquiescence to the written description rejection; the specification includes written description of claims 43 and 44, prior to the amendments.

Applicants request that the rejection of claims 43 and 44 be withdrawn.

**C. The Indefiniteness Rejections Are Overcome**

The Action rejects claims 28, 31, 32, 35, 39, 43, and 44 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants note that the appropriate claims have been revised. The indefiniteness rejections of these claims are therefore rendered moot and should be withdrawn.

**D. Claims 22-27, 29, 30, 33-35, 38, and 40-44 Are Not Anticipated by the Cited References**

The Action presents two separate anticipation rejections under 35 U.S.C. § 102(a) for claims 22-27, 29, 30, 33-35, 38, and 40-44. The Action contends that references WO 01/36507 and WO 01/36508 (the '507 and '508 Applications) both disclose "an optical polymerizate, suitable for the production of optical lens material having a refractive index that exceeds that claimed." The Action, page 3. It is also contended that these references teach that "the polymerizate is produced from an isocyanate functional prepolymer and an aromatic primary diamine, wherein the reactants contain sulfur atoms." *Id.*

Applicants disagree. Claims 22-27, 29, 30, 33-35, 38, and 40-44 are not anticipated by the cited references.

The '507 and '508 Applications appear to concern a method of preparing a polymerizate, which includes a step of polymerizing a two-component composition. See, the Abstract of the

'507 and '508 Applications. The first component appears to be at least one polycyanate reactant and the second component appears to include at least one polyamine reactant. *Id.* These references also indicate that disulfide linkages can be used. *See, e.g., id.* at pages 7-8. It is known to those of ordinary skill in the art that the use of disulfide linkages have disadvantages such as inducing yellowness of a compound or being susceptible to nucleophilic attacks.

By contrast, Applicants presently claim “a transparent, non-elastomeric, polythiourethane/urea material comprising the reaction product of: (a) at least one ( $\alpha$ ,  $\omega$ )-diiso(thio)cyanate prepolymer ... **being free from disulfide (-S-S-) linkage**, and (b) at least one aromatic primary diamine ... **being free from disulfide (-S-S-) linkage....**” Claim 22.

The Action has failed to show that the '507 and '508 Applications discloses every element of Appellant's claimed invention—a burden that the Examiner must carry. *See In re Sun*, 31 U.S.P.Q.2d 1451 (Fed. Cir. 1993); *see also Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (noting that “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.”). For instance, the Action has not shown that the cited references disclose either a “( $\alpha$ ,  $\omega$ )-diiso(thio)cyanate prepolymer ... being free from disulfide (-S-S-) linkage” or an “aromatic primary diamine ... being free from disulfide (-S-S-) linkage....” It does not appear that the cited references teach these claimed elements.

For at least these reasons, the rejection of claims 22-27, 29, 30, 33-35, 38, and 40-44 under 35 U.S.C. § 102(a) should be withdrawn.

#### **E. Conclusion**

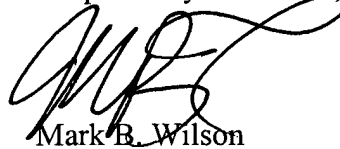
Applicants believe that the present document is a full and complete response to the Office Action dated August 26, 2005. The present case is in condition for allowance, and such favorable action is requested.

**Petition For A Three-Month Extension of Time:**

Pursuant to 37 C.F.R. § 1.136(a), Applicants petition for an extension of time of three months to and including February 28, 2005, in which to respond to the Office Action dated August 26, 2004. Pursuant to 37 C.F.R. § 1.17, a check in the amount of \$1020.00 is enclosed, which is the process fee for a three-month extension of time for a large entity status. If the check is inadvertently omitted, or should any additional fees under 37 C.F.R. §§ 1.16 to 1.21 be required for any reason relating to the enclosed materials, or should an overpayment be included herein, the Commissioner is authorized to deduct or credit said fees from or to Fulbright & Jaworski Deposit Account No. 50-1212/ESSR:058US.

The Examiner is invited to contact the undersigned Attorney at (512) 536-3035 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,



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